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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,284	11/18/2003	Steluta Gina Butuc	PENRECO US 3	6055
21875	7590	01/29/2007		
ARTHUR M DULA LAW OFFICE OF ARTHUR M DULA 3106 BEAUCHAMP STREET HOUSTON, TX 77009			EXAMINER GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/716,284

Applicant(s)

BUTUC, STELUTA GINA

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 14-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group I, claims 1-14 and 25-33, in the reply filed on 11/28/06 is acknowledged. Claims 1-14 and 25-33 are pending in this application. Claims 15-24 are directed to the non-elected invention, which have been cancelled in the response to the restriction requirement. Further, applicant's election of the species mineral oil during the telephone interview on January 11, 2007. Claims 12 and 14 are directed to the nonelected species and are withdrawn.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 26-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 26 recites "said pseudoplastic thickener is selected from *the group consisting of* a mixture comprising from about 2 percent to about 30 percent of a diblock copolymer with from about 70 percent to about 98 percent of a hydrocarbon oil" which is indefinite. The examiner notes the Markush language, however the actual Markush species claimed are unclear. Typically Markush language is "selected from a group consisting of A, B, and C". The context of the Markush language is claim 26 is unclear. Is applicant attempting to claim the pseudoplastic thickener is a diblock copolymer or a hydrocarbon oil? If this is the intended limitation, the examiner suggests applicant removing the phrase "of a mixture comprising" since this phrase is

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unclear in this context. Another interpretation is that claim 26 is attempting to further limit claim 25 by limiting the thickener to a weight percent of 2-30% and the hydrocarbon base of claim 25 to a hydrocarbon oil in the amount of 70-98%. If this is the intended limitation, the examiner suggests applicant remove the phrase "selected from the groups consisting of a mixture comprising". The examiner suggests, "wherein said pseudoplastic thickener is a diblock copolymer in an amount from about 2 percent to about 30 percent and said hydrocarbon base is a hydrocarbon oil in an amount of about 70 to about 98%". An alternative interpretation is that applicant is intending to limit the pseudoplastic thickener itself to a mixture of 2-30% diblock copolymer and 70-98% hydrocarbon oil. If this is the intended limitation, the examiner suggests removing the Markush claim language. For instance, "wherein said pseudoplastic thickener is a mixture of about 2 percent to about 30 percent of a diblock copolymer and about 70 to about 98% of a hydrocarbon oil". For the purpose of applying art, the examiner will apply prior art according to all the above interpretations. The examiner suggests restructuring and clarifying the claims.

Depending on the above interpretation, claims 28 and 33 are indefinite. If the first two interpretations are applied, the claimed range in claim 28 and 33 are outside the claimed range in the parent claim. For instance, if the pseudoplastic thickener is selected from the groups of a diblock copolymer or hydrocarbon oil, 0.2-12% is outside the claimed range of 2-30% or 70-98%.

Claim 29 recites the limitation "said petroleum distillate" in line 1. There is insufficient antecedent basis for this limitation in the claim.

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Claim 33 is directed to a product “comprising a furniture oil wherein said petroleum distillate is a mineral oil, and said pseudoplastic thickener comprises from about 2 percent to about 30 percent of a diblock copolymer and from about 70 percent to about 98 percent of a hydrocarbon oil.” Claim 33 is vague and indefinite since it is unclear if the composition comprises mineral oil, the diblock thickener, and *another* hydrocarbon oil in the amount of 70-98% or if the 70-98% weight percent refers to the mineral oil. Further, it is noted that parent claim 26 already requires 70-98% of a hydrocarbon oil. It is unclear if applicant is attempting to differentiate between the mineral oil and “hydrocarbon oil”.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

**Claims 1-10, 25-26, and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by DesLauriers et al (5,221,534).**

DesLauriers et al disclose hydrocarbon oil gels comprising diblock or triblock copolymers and a hydrocarbon oil. see abstract. The hydrocarbon oil may be selected from paraffinic oil, a naphthenic oil, and mineral oil. see column 6, lines 30-35. The composition preferably comprises 2-6% of the polymer and 94-98% of the hydrocarbon oil. see column 7, lines 45-50. Further solvents including isopropyl myristate, isopropyl palmitate, and organic esters, are used to dilute the gel when the gel is formulated into a cosmetic composition. see column 6, lines 35-45. Table 12 discloses adding a benzoate ester additive to the gel composition. Table 5 discloses the combination of a diblock copolymer with a triblock copolymer (reads on secondary gelling agent).

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With regard to claim 7, the diblock is in the instant weight percent and has the instant molecular weight and thus the composition will be capable of the functional limitation recited in claim 7.

With regard to claim 8, Kraton 1702 has the instant molecular weight.

With regard to claims 9 and 18, it is the examiner's position that the liquid gel has the same viscosity as claimed since the diblock copolymer and hydrocarbon are in the same weight percent.

With regard to claims 26 and 28-33, the 112 rejection should be noted. According to the interpretation that the thickener is a mixture of the diblock copolymer and the hydrocarbon oil, example 6 discloses a composition comprising 10% white oil (refined mineral oil), 3% Kraton 1702, and 87% Drakeol 5 (mineral oil). Therefore, the 10% white oil and 3% Kraton 1702 read on the pseudoplastic thickener in a hydrocarbon base of Drakeol wherein the white oil is contained in an amount of about 77% and the diblock is in an amount of about 23%. According to the interpretation that claim 1 is further limiting the weight percent of the claimed components in claim 25, example table 7 discloses a white mineral oil gel comprising 10% Kraton 1701 and 90% Drakeol 5. Claim 31 is directed to the intended use of the product and since it does not impart a structural limitation, the intended use is not given patentable weight.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-11, 13, and 25-33 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Allison et al (2002/0116867).**

Allison et al disclose a transparent composition comprising 1) a liquid hydrocarbon oil, 2) at least one copolymer selected from a triblock or diblock, or a combination thereof, and 3) at least one derivative of an N-acyl amino acid. See claim 1. The hydrocarbon oil is a mineral oil and utilizes in the amount of 79-91%. See 009-0030 and claim 2-4. Allison teaches when the at least one copolymer is a diblock copolymer, a preferred copolymer is Kraton G-1702 and 1701. See 0036. The copolymer is utilized in an amount of 5-35%, preferably 9-15; and most preferably 5-10%. See 0047 and claim 11-15. The N-acyl amino acid is N-lauroyl-glutamic acid diethyl amide used in an amount of 0.05-2% and preferably 0.1-0.3%. See column [0051] and claims 19-18.

With regard to claim 7, the diblock is in the instant weight percent and has the instant molecular weight and thus the composition will be capable of the functional limitation recited in claim 7.

With regard to claim 8, Kraton 1702 has the instant molecular weight.

With regard to claims 9 and 18, it is the examiner's position that the liquid gel has the same viscosity as claimed since the diblock copolymer and hydrocarbon are in the same weight percent.

With regard to claims 26 and 28-33, the 112 rejection should be noted. Allison meets the interpretation that claim 26 is further limiting the pseudoplastic thickener to a diblock copolymer and the hydrocarbon base to a hydrocarbon oil. Claim 31 is directed to the intended use of the

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product and since it does not impart a structural limitation, the intended use is not given patentable weight.

**Claims 1-10, 25-26, 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Morrison et al (6,433,068).**

Morrison discloses a mineral oil gel comprising 30% titanium dioxide, 3% Kraton 1702, 0.15% Kraton 1650, and 66.85% Drakeol 7 (mineral oil). See example 2. Example 1 discloses a mineral oil gel based on 8.30% Kraton 1702 (diblock), 0.40% Kraton 1650, and Drakeol 7-mineral oil (91.3%).

With regard to claim 7, the diblock is in the instant weight percent and has the instant molecular weight and thus the composition will be capable of the functional limitation recited in claim 7.

With regard to claim 8, Kraton 1702 has the instant molecular weight.

With regard to claims 9 and 18, it is the examiner's position that the liquid gel has the same viscosity as claimed since the diblock copolymer and hydrocarbon are in the same weight percent.

With regard to claims 26 and 28-33, the 112 rejection should be noted. Allison meets the interpretation that claim 26 is further limiting the pseudoplastic thickener to a diblock copolymer and the hydrocarbon base to a hydrocarbon oil. Claim 31 is directed to the intended use of the product and since it does not impart a structural limitation, the intended use is not given patentable weight.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or



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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-7, 10, 25-26, and 28-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 11/343796. Although the conflicting claims are not identical, they are not patentably distinct from each other because:**

Instant claims are directed to a composition comprising a hydrocarbon fluid mixed with a diblock copolymer.

Copending claims are directed to a gelled composition comprising 0-99% of one or more hydrocarbons; 10-20% of a gelling agent; and 1-80% of a polar hydrocarbon. Dependent claims are directed to the gelling agent is a “styrenic” diblock and triblock copolymer combination.

The difference between the instant claims and copending claims is that the instant claims are directed to a specific gelling agent, i.e. diblock copolymer whereas US ‘796 is directed to the genus. However, the dependent claim is directed to a diblock copolymer and thus rendering the

composition as claimed in the instant claims. Therefore, both applications are directed to similar subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Claims 1-7, 25, 29-31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6881776. Although the conflicting claims are not identical, they are not patentably distinct from each other because:**

Instant claims are directed to a composition comprising a hydrocarbon fluid mixed with a diblock copolymer.

US '776 is directed to a two-phase gel composition comprising a gelled ester comprising a mixture of an ester compound and a polymer compound selected from the group consisting of triblock copolymers, star polymers, radial polymers, multi-block copolymers, and a combination thereof, the gelled ester composition having a viscosity; and a hydrophobic, non polar solvent, the solvent. Dependent claims are directed to diblock copolymers, mineral oil as the hydrophobic solvent, and long chain esters as the ester compound. The dependent claims are directed to the solvent present in an amount of 5-95%.

The difference between the instant claims and US is that the instant claims are directed to a specific gelling agent, i.e. diblock copolymer whereas US '776 is directed to the genus. However, the dependent claim is directed to a diblock copolymer and thus rendering the composition as claimed in the instant claims. Therefore, both are directed to similar subject matter.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Sharmila S. Gollamudi  
Examiner  
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